

### REMARKS

This responds to the Office Action dated on March 20, 2006. Claims 1, 9, 10, 25, 30, 36, are amended. Claim 2 is canceled. Claims 62-64 are added. As a result, claims 1, 3-11, 25-31, 36-42, and 63-64 are now pending in this application.

### Claim Objections

Claims 1-11, 25-31 and 36-42 were objected to due to certain following informalities, which are addressed individually below.

1. The Office Action states:

For example, claim 1, recite “a user inquiry including language without any definition or reference given to what is meant by language. Is it meant to be Query protocol language or natural language or simple text? It is not clear what language is referencing. Appropriate correction is required. Claims 25 and 31 have similar recitation.

(Office Action at 2.) Applicant respectfully traverses on the grounds that the user of the term language is not meant to be limited to any particular type of language, and one of ordinary skill in the art would understand the claimed usage of language in a user query in the context of the entirety of the present patent application. Accordingly, Applicant respectfully requests withdrawal of this basis of objection to these claims.

2. The Office Action objected to the use of “if” statements in the claims. Accordingly, Applicant has amended the claim language to recite “when”. Accordingly, Applicant respectfully requests withdrawal of this basis of objection to these claims.

3. The Office Action asserts that claims 3, 4, 26, and 27 are objected to as failing to further limit their based claims, based on the use of the “if” language in the base claims. Since Applicant has amended such base claims, Applicant requests reconsideration and withdrawal of this basis of objection to claims 3, 4, 26, and 27.

4. The Office Action asserts that claims 25 and 31 have similar language. However, because claim 31 recites a computer-readable medium, it is believed to further limit claim 25. Accordingly, Applicant respectfully requests withdrawal of this basis of rejection of claims 25 and 31.

5. The Office Action asserts that the use of “includes as evidence” in claims 25 and 36 is vague and indefinite and fails to add functionality to the claim. Applicant respectfully submits that one of ordinary skill in the art, after having reviewed the present patent specification (see, e.g., Application at 15), would understand the usage of evidence as recited in these claims. Accordingly, Applicant respectfully requests withdrawal of this basis of objection to these claims.

6. The Office Action objected to duplication of the word “that” in claim 9. Applicant has amended claim 9 to overcome this objection. Accordingly, Applicant respectfully requests withdrawal of this basis of objection to claim 9.

7. The Office Action asserts that the use of “a concept” in claims 1, 25, and 36 is without sufficient antecedent basis. Applicant has amended claims 1, 25, and 36 to clarify. Accordingly, Applicant respectfully requests withdrawal of this basis of objection to claims 1, 25, and 36.

8. The Office Action states:

Similarly, claims 3, and 4, recite the limitation “at least one indication of at least one document” which was previously introduced in Independent claim 1, line 12. There is insufficient antecedent basis for this limitation in the claim. Correction is required.

(Office Action at 4.) Applicant respectfully traverses. The cited portion of claim 1 recites “at least one indication of at least one document associated with the at least one *matched* concept,” which is actually different from the “at least one indication of at least one document associated with the *end-user-selected related* concept,” as recited in claims 3 and 4. Accordingly, Applicant respectfully requests withdrawal of this basis of objection to claims 3 and 4.

9. The Office Action states:

Similarly, claims 26, and 27 recite the limitation “at least one indication of at least one document” which was previously introduced in Independent claim 25, line 17. There is insufficient antecedent basis for this limitation in the claim. Correction is required.

(Office Action at 4.) Applicant respectfully traverses on the grounds that “at least one indication of at least one document associated with the at least one end-user-selected related concept,” as recited in claim 26, for example, is actually different from the “at least one indication of at least one document associated with the at least one matched concept,” as recited in claim 25. Accordingly, Applicant respectfully requests withdrawal of this basis of objection to these claims.

10. The Office Action objected to claim 2 and its recitation of at least one indication of the at least one matched concept in line 2.” Claim 2 has been cancelled, thereby mooting this basis of objection.

11. The Office Action states:

Claim 5 recites “at least one indication of the matched concept” in line 2. However, “at least one indication” was initially introduced in the dependent claim 4, in line 4, of which claim 5 depends, is this a new indication that is being introduced or the same original indication of the matched concept? There is insufficient antecedent basis for this limitation in the claim. Similarly, claims 5, and 8 have similar language. Clarification is required.

(Office Action at 5.) Applicant respectfully traverses. Claim 4, line 4 recites “an indication of the at least one *document* associated with both the end-user-selected related concept and the at least one matched concept,” which is actually different from claim 5, which recites “presenting to the end-user an indication of the at least one matched concept.” Accordingly, Applicant respectfully requests withdrawal of this basis of objection to this claim.

12. The Office Action objected to claim 28 for its recitation of “at least one indication of at least one related concept” in line 2. Applicant has amended claim 28 to recite “the at least one

indication of the at least one related concept.” Accordingly, Applicant respectfully requests withdrawal of this basis of objection.

13. The Office Action objected to “at least one end user” in claim 9, because the preamble of claim 1 recites “an end user.” However, Applicant respectfully submits that one of ordinary skill in the art would recognize that the “at least one end user” of claim 9 can be different than the “end user” in the preamble of claim 1. Accordingly, Applicant respectfully requests withdrawal of this basis of objection to claim 9.

If the Examiner continues to have objections to any of the above formalities, the Examiner is invited to telephone Applicant’s counsel, Suneel Arora, at 612-373-6951, since Applicant’s counsel is confident that any remaining issues can be quickly discussed and resolved.

#### §101 Rejection of the Claims

1. Claims 1, 25 and 36 were rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter as not producing any tangible result or being limited to a practical application. The Office Action notes that the use of a computer has not been indicated. Applicant respectfully traverses this rejection.

First, Applicant respectfully submits that there is a tangible result of “presenting to the end-user . . . at least one indication . . .” Therefore, Applicant respectfully submits that the amended claim fully comports with 35 U.S.C. § 101. Moreover, while not yet constituting substantive rulemaking, the “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility” are believed by the Office to be fully consistent with binding precedent of the Supreme Court, the Federal Circuit and the Federal Circuit’s predecessor courts. The Interim Guidelines state in Annex III, that it is immaterial whether some or all the steps could be carried out by the human mind. Also, the claims in *Ex parte Lundgren*, Appeal No. 2003-2088, Application 08/093,516, (Precedential BPAI opinion September 2005) do not recite any computer, and could easily be carried out by the human mind without a computer. *Ex parte Lundgren* also clearly puts to rest the “technological arts” test. The claims clearly provide a practical application, that of a useful indication provided to a user. Thus, the claims are believed

to clearly recite statutory subject matter, as illustrated by the Interim Guidelines, and confirmed by Ex parte Lundgren. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this basis of rejection of these claims.

2. Claims 11, 31 and 42 were rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. Applicant respectfully traverses this rejection.

The Office Action states:

Claims 11, 31, and 42 are not limited to tangible embodiments. In view of Applicant's disclosure, specification paragraph 0033 and paragraph 0288, the medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., floppy disks, hard drives, CD-ROM or DVD media or any other read-write or read-only memory device) and intangible embodiments (e.g., transmission or display devices). As such the claim is not limited to statutory subject matter and is therefore non-statutory.

(Office Action ¶ 6.) Applicant respectfully disagrees. Claims 11, 31 and 42 specifically recite "a computer-readable medium." The specification of the present patent application, at paragraph 0288, specifically lists tangible media and does not list any intangible media. Although the specification at paragraph 0033 apparently mentions processing data represented as physical quantities on (among other things) transmission or display devices, such mention in paragraph 0033 is entirely unconnected with any definition (or even any recitation) of the term "computer-readable media." In sum, Applicant respectfully submits that there is absolutely no explicit and deliberate definition in the present patent specification that would lead one of ordinary skill in the art to believe that the claimed computer-readable medium encompasses any non-statutory subject matter. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this basis of rejection of these claims.

#### §102 Rejection of the Claims

Claims 1-11, 25-28 and 31 were rejected under 35 U.S.C. § 102(e) for anticipation by Foulger et al. (U.S. Patent No. 6,578,022 B1). Applicant respectfully traverses.

Applicant cannot find in the cited portions of Foulger any disclosure of receiving a query, using the query to retrieve documents, obtaining one or more matched concepts from the retrieved documents, and then presenting to the end user an indication of a document and a matched concept, as presently similarly recited or incorporated in these claims. Instead, Foulger

apparently uses a suggestion engine 120 to search a suggestion space completely independently from what is contained in the returned documents. (*See, e.g.*, Foulger at col. 9, lines 50-60.) This requires first building the suggestion space—which is a complicated task, particularly if the knowledge domain of interest is not very well defined or highly variable. By contrast, the present claims present a more focused and flexible alternative that avoids the onerous burden of constructing a suggestion space—by extracting concepts out of the very retrieved documents that are returned by the search executed using the query.

Moreover, concerning dependent claims 29-30, Applicant cannot find in the cited portions of Foulger any disclosure of ranking related concepts includes ranking using a number of times that that the related concept was previously-selected by at least one end-user, as recited in dependent claim 29, or of promoting a related concept in the ranking when a previous selection by an end-user resulted in an inferred success in returning at least one relevant document, as recited in dependent claim 30. In fact, the Office Action failed to address claims 29-30. Accordingly, because no basis for rejecting dependent claims 29-30 has been provided, Applicant respectfully requests allowance of these claims or, if a basis of rejection is provided in the next Office Action, Applicant respectfully requests that Applicant be given a full and fair opportunity to respond.

In sum, because all elements of the present claims are apparently not disclosed in Foulger, Applicant respectfully requests withdrawal of this basis of rejection of these claims.

For brevity, Applicant defers (but reserves the right to later present) remarks concerning the dependent claims, which are believed to include separately patentable subject matter.

### §103 Rejection of the Claims

Claims 36-42 were rejected under 35 U.S.C. § 103(a) over Foulger et al. (U.S. Patent No. 6,578,022 B1).

Applicant respectfully traverses on the grounds that no *prima facie* case of obviousness exists for these claims because all elements are apparently not disclosed, taught, or even suggested in Foulger, for the reasons discussed above with respect to the § 102 rejection.

Furthermore, the Office Action states:

Foulger et al. teaches the claimed invention [except] for in which the primary groups include an Activities group, a Symptoms group, a Products group, and an Objects group.

Foulger et al. does not explicitly teach the subject heading for each primary group as listed in the claim (but teaches it to be user defined), however he teaches user assigned primary search groups/dimensions/categories (See column 19, lines 44-51, teaches different groups of related search categories/dimensions, also see column 20, lines 48-49).

It would have been obvious to one having ordinary skill in the art at the time that the invention was made to assign different headings to primary concept groups since it is known in the database art that concept groups are user definable (non-functional descriptive material does not add functionality to the claim and any type of content can be stored and defined in a knowledge base).

(Office Action at 14.) However, this ignores the fact that the group types are not merely non-functional descriptive material, but are instead categories that are carefully chosen such that, in combination, they provide highly useful suggestions of related concepts that are useful to the user's particular needs. In sum, such categories clearly have highly functional attributes, such as expressly described in the present patent application at page 21, line 26 – page 22, line 4.)

In view of the above, Applicant respectfully requests withdrawal of this basis of rejection of claims 36-42.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6951 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

MAX COPPERMAN ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.

P.O. Box 2938

Minneapolis, MN 55402

(612) 373-6951

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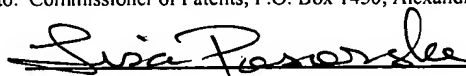
By 

Suneel Arora

Reg. No. 42,267

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 20 day of May, 2006.

LISA ROSORSKE



Name

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